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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,128	06/24/2003	Brian L. Wilt	KMC / 302US	1590

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WOOD, HERRON & EVANS, LLP
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CINCINNATI, OH 45202

EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,128

Applicant(s)

WILT ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-11 is/are rejected.
- 7) ☒ Claim(s) 4-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment of the Declaration filed on 9/19/05. It is noted that in the amendment, applicant has made a change to correct a typo in the specification. There is not any amendment to the claims.

Claim Rejections - 35 USC § 112

2. Regarding the request of clarification of rejection to the claims 1-13 under 35 USC 112, first paragraph (amendment, page 3, second paragraph), the Examiner confirms that the rejections of claims 1-13 under 35 USC 112, first paragraph, are now withdrawn because the applicant's arguments provided in the amendment of 1/26/05, pages 15-18, are persuasive.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 8-10, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada (U.S. Patent No. 4,865,438, of record) in view of Kelman (U.S. Patent No. 4,833,890, of record).

See the rejection as set forth in the Office action of 5/17/05, pages 3-5.

5. Claims 1-3, 6, 8 and 10, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom (U.S. Patent No. 3,273,456, of record) in view of Kelman (U.S. Patent No. 4,833,890, of record)

See the rejection as set forth in the Office action of 5/17/05, pages 5-8.

6. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom in view of Kelman as applied to claims 6 and 10 above, and further in view of Caplan et al (U.S. Patent No. 6,061,189, of record).

See the rejection as set forth in the Office action of 5/17/05, page 8.

Allowable Subject Matter

7. Claims 12-13 are allowed.

8. Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed on 9/19/2005 have been fully considered but they are not persuasive for the following reasons.

A) Regarding to the rejection of claims 1 and 8-10 under 35 USC 103(a) over the art of Wada and Kelman, applicant's arguments provided in the amendment of 9/19/05, pages 4-6, have been fully considered but they are not persuasive for the following reasons.

First, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second, in response to applicant's argument that the lens provided by Kelman is an intraocular lens, and the device as claimed is directed to an optical loupe, the Examiner respectfully disagrees and invited the applicant to review the rejection to the claims. The rejection to the present claims is based on a combination of art provided by Wada and Kelman. Applicant should note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Third, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each Wada and Kelman discloses a lens element for use with an optical system wherein the lens element has a non-circular shape. As stated in the rejection, the only feature missing from the art of Wada is that he does not state that the horizontal peripheral edges of the lens have

arcuate shapes as claimed in the present claims. However, the rejection has also emphasized that the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and no critical to the device as claimed. The support for that conclusion is found in the present specification in page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is a reduction in weight (see present specification in page 4, section [0010]). In other words, the change in shape of the lens used in the device does not affect to the performance of the device. In that viewpoint, then the non-circular objective lens used in the magnification viewer provided by Wada meets the advantage related to the reduction in weight of the lens. The art of Kelman is used in the rejection to show that a lens element having its horizontal curved/arcuate peripheral edges used in combination with other optical element of an optical device is known to one skilled in the art. In particular, in column 8 and fig. 6, Kelman teaches a lens having a non-circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. It is also noted that the use of a non-circular shaped lens is an alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment

described in columns 4-5 and shown in figure 1. It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See *In re Dailey*, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Wada by using an objective lens element having a non-circular shape in which the horizontal peripheral surfaces of the lens element have accurate shape as suggested by Kelman for the purpose of reducing the effects of flare/harmful light to the optical quality of the viewer.

Fourth, in response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

B) Regarding to the rejection of claims 1-3, 6, 8 and 10 under 35 USC 103(a) over the art of Feinbloom and Kelman, applicant's arguments provided in the amendment of 9/19/05, pages 6-7, have been fully considered but they are not persuasive for the following reasons.

First, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second, in response to applicant's argument that the lens provided by Kelman is an intraocular lens, and the device as claimed is directed to an optical loupe, the Examiner respectfully disagrees and invited the applicant to review the rejection to the claims. The rejection to the present claims is based on a combination of art provided by Feinbloom and Kelman. Applicant should note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Third, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each Feinbloom and Kelman discloses a lens element for use in an optical system wherein the lens element has a non-circular

shape. As stated in the rejection, the only feature missing from the art of Feinbloom is that he does not state that the horizontal peripheral edges of the lens have arcuate shapes as claimed in the present claims. However, the rejection has also emphasized that the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and not critical to the device as claimed. The support for that conclusion is found in the present specification in page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is a reduction in weight (see present specification in page 4, section [0010]). In other words, the change in shape of the lens used in the device does not affect to the performance of the device. In that viewpoint, then the non-circular objective lens used in the magnification viewer provided by Feinbloom meets the advantage related to the reduction in weight of the lens. The art of Kelman is used in the rejection to show that a lens element having its horizontal curved/arcuate peripheral edges used in combination with other optical device is known to one skilled in the art. In particular, in column 8 and fig. 6, Kelman teaches a lens having a non-circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. It is also noted that the use of a non-circular shaped lens is an

alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment described in columns 4-5 and shown in figure 1. It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See *In re Dailey*, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Feinbloom by using an objective lens element having a non-circular shape in which the horizontal peripheral surfaces of the lens element have accurate shape as suggested by Kelman for the purpose of reducing the effects of flare/harmful light to the optical quality of the viewer.

Fourth, in response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

C) Regarding to the rejection of claims 7 and 11 under 35 USC 103(a) over the art of Feinbloom, Kelman and Caplan et al, applicant's arguments provided in the amendment of 9/19/05, pages 7-8, have been fully considered but they are not persuasive.

It is noted that in the arguments, applicant has argued that the art of Caplan does not cure the deficiencies because Caplan et al disclose a circular objective lens. While the Examiner has agreed to the applicant's opinion about the shape of the objective lens disclosed in the art of Caplan et al; however, applicant is respectfully invited to review the rejection in which the art of Caplan et al used in the rejection is for the purpose of showing one skilled in the art the use of different correction lenses having different optical characteristics for the purpose of varying a working distance and for the purpose for adjusting the working distances as well as the contrast.

10. The Declaration filed by Brian L. Wilt under the rule of 37 CFR 1.132 on 9/19/2005 has been fully considered but it is not persuasive and thus is not sufficient to overcome the rejections of claims 1-3 and 6-11 under 35 USC 103(a) over the applied art.

In the Declaration, applicant has stated that the product resulted from the present claims has obtained a commercial success and applicant has provided some data to support for that statement. However, the data as provided in the Declaration is not sufficient to prove that the device as claimed obtained a commercial success. Applicant has not provided any evidence to show that the product sold is indeed used by the buyers. The products of the present claims might be still stocked in shelves or storage of stores/departments. It is also unclear whether the relative numbers showing an increase in volume of product sold is a result of the company stops to sell the so-called "conventional round-type" optical loupe or not. It is also unclear whether the number of

product sold is made due to the discount in prices of the new product. In other words, the Declaration with data as provided is insufficient to overcome the rejections of the present claims with respect to the art provided by Wada, Kelman, Feinbloom and Caplan et al.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

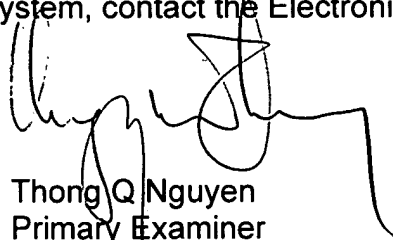
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
